REMARKS

Present Status of the Application

Claims 11-17 are pending in the application.

In the Office Action dated 07-07/2006, the Examiner rejected Claim 9 under 35 U.S.C. 112, second paragraph, Claims 11 and 12 under 35 U.S.C. 102(e) as being anticipated by Matsumoto (US 7,046,600, hereinafter "Matsumoto") and Claims 1, 2-10 and 13-17 under 103(a) as being unpatentable over Nishida (JP 62020153) in view of Matsumobo.

By this Amendment, Applicant has cancelled Claims 1-10 without prejudice or disclaimer. Based on this Amendment and the following reasons, Applicant requests that the rejections to claims 11-17 be withdrawn and the pending claims allowed.

Discussion of Rejection to claims 11 and 12 under 35 USC 102(e)

Applicant respectfully traverses the rejections of Claims 11 and 12 under 35 U.S.C. 102(e) because Matsumoto does not teach every recitation of these claims. In order to properly anticipate Applicant's claimed invention under 102, each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Further,* "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See MPEP §2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." See MPEP § 2131.

Matsumoto discloses a laser power control method and an optical disc recording apparatus which can perform recording with a higher grade at variable levels of the recording linear velocity, capable of performing data recording at the plural levels of the recording linear velocity. The process of laser power control is roughly divided into OPC (Optimum Power Control) control carried out as a preliminary stage of actual recording and LPC (Laser Power Control) control performed in actual recording.

Although the laser power control method disclosed by Matsumoto uses an OPC control to determine a laser power value used for performing actual recording, the OPC control does not perform sampling and holding and obtain laser power based on the sample holding signal. The Examiner asserts that Matsumoto discloses these features on fig. 2 and Col.9 Lines 20-27. See Office Action Page 3, first paragraph. Applicant respectfully disagrees. As described by Matsumoto, during OPC control, an asymmetry degree β (which is associated to a reproduction signal grade) of a reproduction signal is detected from a signal obtained by reproducing the test area. See Matsumoto Fig. 2 and Col. 9 Lines 9-12. Further, the asymmetry degree β can be obtained from the expression (a+b)/(a-b), wherein a peak level of a waveform of the EFM-modulated signal is "a" and a bottom level of the same is "b". See Col. 11 Lines 1-4. In this claimed invention, the meaning of sample and hold is ordinary in this related field and thus definitely distinguishable from the generation of the asymmetry degree β in Matsumoto.

Accordingly, Matsumoto cannot teach a laser power correction method including sampling and holding said signal to obtain a sample holding signal and obtaining said laser power based on said sample holding signal, as recited in claim 11.

Because Matsumoto does not teach each and every limitation of Claim 11, Applicant requests that the rejection of claim 11 under 35 U.S.C. 102(e) be withdrawn and this claim allowable.

Claim 12 depend from Claim 11. As explained, Claim 11 is not anticipated by Matsumoto. Accordingly, Claim 12 is also distinguishable from the citation reference for at least the same reason set forth in connection with base claim 11. Further, this reference fails to teach or suggest recitations of Claim 12.

Further, in Claim 12, a curve fit method is applied to obtain a curve representing a relationship between said operational power parameter and said laser power. The Examiner asserts that Matsumoto discloses these features on Col.9 Lines 22-24. Fig. 2 and Col.9 Lines 22-24 of Matsumoto show a relationship between a recording laser power and the asymmetry degree β. As explained above, the sample and holding signal is distinguishable from the asymmetry degree β. Accordingly, because Matsumoto does not teach each and every limitation of Claim 12, Applicant requests that the rejection of claim 12 under 35 U.S.C. 102(e) be withdrawn and this claim allowable.

Discussion of Rejections of claims 13-17 under 35 USC 103(a)

Claims 13-17 were rejected under 35 U.S.C 103(a) as being unpatentable over Nishida in view of Matsumoto. Applicant respectfully traverses the rejections because the Examiner has failed to establish a prima facie case of obviousness.

To establish a prima facie case of obviousness under 35 U.S.C § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See MPEP § 2143.

The Examiner failed to establish prima facie obviousness in rejecting Claim 13-17 because Nishida and Matsumoto, taken alone or combined, fail to teach or suggest, among other things, all the claim limitations of claims 13-17. Accordingly, Claims 13-17 are patentable over from the citation references for at least the same reason set forth in connection with base claim 11.

Furthermore, the Examiner failed to establish prima facie obviousness because there is no motivation to combine Nishida and Matsumoto. A determination of obviousness must be supported by evidence on the record. See In re Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentablity, including conclusions of obviousness by the Board, must be supported by "substantial evidence" that is a result of a "thorough and searching" factual inquiry. See In re LEE, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting McGinley v. Franklin Sports, Inc., 262 F. 3d 1339, 1351-52).

The Examiner has not shown that a skilled artisan considering Nishida and Matsumoto would have been motivated to combine or modify the references in a manner resulting in the recitations of claim 13-17 without benefit of Applicant's disclosure. Instead, the Examiner merely states that Nishida and Matsumoto are analogous arts and in view of their teaching, it

would have been obvious to provide the apparatus of Nishida with the power control of Matsumoto because it would allow for power control without damaging the recording film. See Office Action, p4, paragraphs 2-3. This conclusion, however, is not properly supported by the references and does not show that a skilled artisan would have combined the references as alleged.

Simply because Nishida and Matsumoto both deal with the same field of recording does not demonstrate that a skilled artisan would have been motivated to modify the cited arts as alleged. The MPEP makes clear that: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations." See MPEP 2145.01.

The Examiner has not shown that the cited art "suggests the desirability" of the alleged combination. Indeed, there is no reason why, without gleaning information from the Applicant's disclosure, an artisan would modify the Nishida's apparatus with the power control method of Matsumoto.

(I) Dividing the process of laser power control into preliminary OPC control and actual LPC control, as taught by Matsumoto and (II) eliminating the damage of a recording disc by defocusing, as taught by Nishida, are not the same thing. The later associates to crystallize the recording disc completely and the former enables a high recording quality. As such, Applicant submits that the Examiner's conclusion to add selective portions of Matsumoto to cure the deficiencies of Nishida was reached through improper hindsight and without concern for the desirability of the combination. Therefore, the Examiner has failed to provide proper suggestion or motivation to combine Nishida and Matsumoto in a manner resulting in the invention recited

in Claims 13-17. Therefore, Applicant respectfully requests rejections of these claims be withdrawn and the claims allowable.

Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all rejections have been traversed, rendered moot, and/or accommodated, and that the now all pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,
J.C. PATENTS

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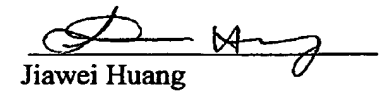

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